UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,008	01/31/2001	Sang-hyun Shin	Q62027	2294

7590 08/25/2006	EXAMINER
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC	PATEL, ASHOKKUMAR B

2100 PENNSYLVANIA AVENUE, N.W.	ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037-3213	2154	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 May 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9, 12 and, 15-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-18 are presented for examination. Claims 10, 11 13, and 14 are

cancelled.

Response to Arguments

2.   Applicant's arguments filed 05/22/2006 have been fully considered but they are

not persuasive for the following reasons:

Applicant's argument:

"Not only is the UIN described as being generated from the GSM mobile phone

number, there is nothing in the specification which mentions or suggests that the UIN is

an IP address. See paragraph 61. Although Mendiola discloses generating an email

address for a user by prepending the UIN to a domain name, an email address is still

not an IP address of a terminal, as recited in the claim."

Examiner's response:

Applicant has a very narrow view of the reference's teachings of IM (instant

Messaging) system. As taught by the reference at para. [0043], "The types of clients

that may be connected to such an IM system include: GSM mobile clients, PC-based

clients, internet browser clients, and email clients. This is essentially made possible by

the IM system having basic enabling functions residing within the IM server and by

using a unique identifier in the form of a single Unique Identification Number ("UIN") for

a user, <u>regardless of the appliance or client type</u> used by that user for accessing the IM

server."

And as such it teaches in para. [0123], "Message exchange with GSM clients will in particular be as easy as the GSM client user sending an SMS message to a numeric address consisting of the GSM carrier "access code" plus the UIN. "

Also in para. [0096], the reference is clearly stating that "It should be noted that although the message dispatcher sends the notification back to the prospective user as an email message, it is designed to send the notification back through any <u>access media permitted by the IM system</u> and nominated by the prospective user, eg PC client application, <u>GSM mobile phone internet browser client application</u>, as well as email application."

Also in para. [0034], "database means for storing the matched unique identifier and client specific access address under the unique identifier."

Therefore, the reference teaches that the IP addresses are being exchanged for the transmission of the Instant messages.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-9, 12, 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Mendiola et al. (hereinafter Mendiola)(US 2002/0006803 A1).

Referring to claim 1,

Mendiola teaches a method of performing an Internet protocol (IP)-based communication between wireless terminals (para. [0096] It should be noted that although the message dispatcher sends the notification back to the prospective user as an email message, it is designed to send the notification back through any access media permitted by the IM system and nominated by the prospective user, e.g. PC client application, <u>GSM mobile phone internet browser client application,</u> as well as email application."), the method comprising the steps of:

(a) receiving a request for an IP address of a second terminal from a first terminal; (para. [0111] It should be noted that a peculiar situation arises when an electronic invitation is sent to a prospective email-based client by a GSM client. Moreover, <u>using a UIN as the primary means of addressing messages is essential to the efficient exchange of messages between these two client types.</u> As previously described, GSM clients <u>primarily send</u> instant messages by directing them to numeric addresses or <u>GSM mobile phone numbers</u>, not alphanumeric names. In the light of this, it is necessary for <u>GSM clients to embed the email address of the target recipient in the message containing the invitation</u> and route it via the IM server for delivery to the email client. In order to do this, the message is sent to a universal access number, as defined by the carrier, for the processing of email-targeted messages." And para.[0015])

(b) upon receipt of the request, checking whether an (IP) address corresponding to the second terminal is registered, and (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address

server (para.[0107] [0107] Thus existing members of the IM community can send an invitation to a prospective member to join the community by triggering the IM system server. The invitation is in electronic form and may come from any type of client insofar as the present mode is concerned, eg an SMS message from a OSM device, an internet signal from a PC-based or internet browser-based client application, or a regular e-mail message., and [0109], Once triggered, the IM system server sends an invitation to a target new user in the form of an e-mail message. Before sending the e-mail invitation, the IM system server invokes the registration handler to tentatively register the prospective user. In so doing, as previously described, the registration handler invokes the UIN assigner to assign a new UIN to the target user's e-mail address." And Fig. 4, para.[0113]-0123],

wherein the first terminal is a first wireless terminal and the second terminal is a second wireless terminal. ([0054] As shown, a GSM client 11 is connected via a wireless communication medium involving cellular telecommunication sites 13 to a GSM carrier network 15. The GSM carrier network 15 is turn connected via a direct electronic link or the internet 17, to the IM server 19 of the IM system. It is important to have a direct electronic or internet link 17 between the GSM carrier network 15 and the IM server 19 in order to complete the IM system. [0055] Within the GSM carrier network 15, or more precisely the SMSC or message server system 21 thereof, a numeric "access code" must be defined which essentially directs important information contained in an SMS message sourced by the GSM client 11 to the IM server 19. [0056] The information contained in the SMS message that is of importance to the IM system

includes the following: [0057] the mobile number 23 of the sender, [0058] the text of the

SMS message 25, and [0059] the numeric address 27 of the recipient."

Referring to claim 2,

Mendiola teaches the method of claim 1, wherein in the step (a), the request for

an IP address is made using a telephone number, and wherein in the step (b), checking

whether an IP address corresponds to the second terminal is carried out by checking

whether the telephone number corresponds to the second terminal. (([0054] As shown,

a GSM client 11 is connected via a wireless communication medium involving cellular

telecommunication sites 13 to a GSM carrier network 15. The GSM carrier network 15

is turn connected via a direct electronic link or the internet 17, to the IM server 19 of the

IM system. It is important to have a direct electronic or internet link 17 between the

GSM carrier network 15 and the IM server 19 in order to complete the IM system. [0055]

Within the GSM carrier network 15, or more precisely the SMSC or message server

system 21 thereof, a numeric "access code" must be defined which essentially directs

important information contained in an SMS message sourced by the GSM client 11 to

the IM server 19. [0056] The information contained in the SMS message that is of

importance to the IM system includes the following: [0057] the mobile number 23 of the

sender, [0058] the text of the SMS message 25, and [0059] the numeric address 27 of

the recipient.")

Referring to claim 3,

Mendiola teaches the method of claim 1, further comprising the step of sending a

notice requesting the second terminal to establish an IP connection if the IP address is

not registered. ([0116] Step 2; IM server system assigns a UIN to the target new user

and email address of target new user [0117] The registration handler 119 of the IM

server system 113 causes the UIN assigner to generate a UIN to be assigned and

matched to John Smith's email address in the manner previously described. For this

illustration, UIN 12125556666 is matched to johnsmith@company.com and is assigned

to John Smith as his unique ID for the purpose of handling messages by the IM server

system. This mapping will be stored 121 in the user database 123 for future use

125.[0118] Step 3: Message is sent to the target new user. [0119] The IM server sends

an email 129 to the prospective user John Smith 127 at johnsmith@company.com. The

message is an invitation by Dennis for John to be a member of the IM community and

an authorized "buddy" of Dennis. Detailed and additional instructions on how to

complete the registration process are contained in the body 131 of the message. The

subject 133 of the email contains such information John's UIN (e.g., 12125556666) and

temporary password. The message 129 also gives the option for John to download the

PC-based application with which John Smith can also use to complete the optional

registration procedure. For the purposes of this illustration, the "From" email address is

639175336647@Chikka.com. The user ID portion of this email address is the UIN of

Dennis. (The "From" address can also be some other address that is directed to the IM

server system, which if sent there, the IM system server would be able to process

accordingly for the purpose of completing John Smith's registration.) In the present

example, the email 129 is routed via John's company's email system 135 which

includes a SMTP server 137 and a POP/IMAP server 139.")

Referring to claim 4,

Mendiola teaches the method of claim 3, wherein in the step of sending a notice requesting the second terminal to establish an IP connection, said notice is sent using a Short Message Service (SMS). ([0123] Message exchange with GSM clients will in particular be as easy as the GSM client user sending an SMS message to a numeric address consisting of the GSM carrier "access code" plus the UIN.)

Referring to claim 5,

Mendiola teaches the method of claim 1, wherein if the IP address is registered, further comprising the step of transmitting the IP address to one of a plurality of terminals, said plurality of terminals including said first terminal.([0121] John Smith agrees to join the IM community by simply replying 141 to the email message. This action immediately prompts the IM server system 113 that John Smith has agreed to join the IM community and that he has authorized Dennis to be included in his "buddy" list; hence, John Smith can receive instant messages from Dennis and Dennis can be notified of John's "online"status.)

Referring to claim 6,

Mendiola teaches the method of claim 5, wherein the IP address is transmitted to said one of a plurality of terminals using transmission control protocol/internet protocol (TCP/IP) or user datagram protocol/internet protocol (UDP/IP). (para. [0096] It should be noted that although the message dispatcher sends the notification back to the prospective user as an email message, it is designed to send the notification back through any access media permitted by the IM system and nominated by the

prospective user, e.g. PC client application, <u>GSM mobile phone internet browser client</u>

<u>application,</u> as well as email application.").

Referring to claim 7,

Mendiola teaches communication system having a first wireless terminal and a

second wireless terminal (para. [0096] It should be noted that although the message

dispatcher sends the notification back to the prospective user as an email message, it is

designed to send the notification back through any access media permitted by the IM

system and nominated by the prospective user, e.g. PC client application, <u>GSM mobile</u>

<u>phone internet browser client application,</u> as well as email application."),, an internet

protocol (IP) address server, and a name server for providing an IP address at the

request of the first wireless terminal, wherein the name server ([0030] Preferably, said

client types connected to the computer network via the GSM network have SMS

capability and are <u>initially connected via an SMSC server</u> to control and manage said

SMS therebetween, and wherein said SMSC server is directly connected to said <u>IM</u>

<u>server</u> via said computer network. In accordance with another aspect of the present

invention, there is provided a system for assigning a unique identifier to a prospective

user of an instant messaging system comprising a plurality of clients having IM

applications of the same or different types, selectively interconnected to an IM server <u>by</u>

<u>way of a computer network,</u>") comprises:

a database for storing IP addresses corresponding to telephone numbers of a

plurality of terminals, said plurality of terminals including the second wireless terminal

([0034] database means for storing the matched unique identifier and client specific access address under the unique identifier); and

a controller which assigns an IP address to the second wireless terminal corresponding to information from the IP address server, if the IP address of the second wireless terminal that is requested by the first wireless terminal using a telephone number is not registered, and registers the assigned IP address in the database.([0031] a registration handling means for receiving a client specific access address of a prospective user on the computer network together with a request to register or tentatively register said prospective user; [0032] a unique identifier assigning means to automatically allocate said unique identifier to said prospective user and match said unique identifier to the client specific address of the prospective user; [0033] account processing means to register or tentatively register an account for said prospective user; [0035] a message dispatching means for sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, either: confirming the registering of the prospective user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user.)

Referring to claim 8,

Mendiola teaches a name server in an internet protocol (IP)-based communication system comprising: a communication module unit for sending and receiving œ-based data; a controller for registering telephone numbers and requests for

translation of wireless telephone numbers into IP addresses; and a database for storing

IP addresses and wireless telephone numbers as determined by the controller, wherein

the communication module unit sends and receives IP-based data to and from external

devices and the external devices include IP address servers. ([0030] Preferably, said

client types connected to the computer network via the GSM network have SMS

capability and are initially connected via an SMSC server to control and manage said

SMS therebetween, and wherein said SMSC server is directly connected to said IM

server via said computer network. In accordance with another aspect of the present

invention, there is provided a system for assigning a unique identifier to a prospective

user of an instant messaging system comprising a plurality of clients having IM

applications of the same or different types, selectively interconnected to an IM server by

way of a computer network, the system comprising: [0031] a registration handling

means for receiving a client specific access address of a prospective user on the

computer network together with a request to register or tentatively register said

prospective user; 0032] a unique identifier assigning means to automatically allocate

said unique identifier to said prospective user and match said unique identifier to the

client specific address of the prospective user; [0033] account processing means to

register or tentatively register an account for said prospective user; [0034] database

means for storing the matched unique identifier and client specific access address

under the unique identifier; and [0035] a message dispatching means for sending

notification of said unique identifier to said prospective user at the client specific

address of the prospective user, either: confirming the registering of the prospective

user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user.)

Referring to claim 9,

Mendiola teaches the name server of claim 8, wherein the name server further comprises a memory for storing a program for operating the controller.([0035] a message dispatching means for sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, either: confirming the registering of the prospective user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user.)

Referring to claim 12,

Mendiola teaches the name server of claim 8, wherein the controller receives requests for translation of telephone numbers into IP addresses from the communication module unit.(([0034] database means for storing the matched unique identifier and client specific access address under the unique identifier)

Referring to claim 15,

Mendiola teaches the communication system of claim 7 further comprising a communication module unit which sends the assigned IP address to the first wireless terminal. 0121] John Smith agrees to join the IM community by simply replying 141 to the email message. This action immediately prompts the IM server system 113 that

John Smith has agreed to join the IM community and that he has authorized Dennis to be included in his "buddy" list; hence, John Smith can receive instant messages from Dennis and Dennis can be notified of John's "online" status.)

Referring to claim 16,

Mendiola teaches the communication system of claim 7, wherein said name server receives a request for the IP address of the second wireless terminal from the first wireless terminal.((para. [0111] It should be noted that a peculiar situation arises when an electronic invitation is sent to a prospective email-based client by a GSM client. Moreover, using a UIN as the primary means of addressing messages is essential to the efficient exchange of messages between these two client types. As previously described, GSM clients primarily send instant messages by directing them to numeric addresses or GSM mobile phone numbers, not alphanumeric names. In the light of this, it is necessary for GSM clients to embed the email address of the target recipient in the message containing the invitation and route it via the IM server for delivery to the email client. In order to do this, the message is sent to a universal access number, as defined by the carrier, for the processing of email-targeted messages." And para.[0015])

(b) upon receipt of the request, checking whether an (IP) address corresponding to the second terminal is registered, and (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server (para.[0107] [0107] Thus existing members of the IM community can send an invitation to a prospective member to join the community by triggering the IM system

server. The invitation is in electronic form and may come from any type of client insofar as the present mode is concerned, eg an SMS message from a OSM device, an internet signal from a PC-based or internet browser-based client application, or a regular e-mail message., and [0109], Once triggered, the IM system server sends an invitation to a target new user in the form of an e-mail message. Before sending the e-mail invitation, the IM system server invokes the registration handler to tentatively register the prospective user. In so doing, as previously described, the registration handler invokes the UIN assigner to assign a new UIN to the target user's e-mail address." And Fig. 4, para.[0113]-0123]

Referring to claims 17 and 18,

Mendiola teaches method of claim 1, wherein the IP address corresponding to the second terminal or the IP address assigned to the second terminal is unique to the second terminal, and the method of claim 17, wherein the IP address corresponding to the second terminal or the IP address assigned to the second terminal is transmitted to the first terminal. para. [0096], [0043], . [0123], Note: Therefore, the reference teaches that the IP addresses are being exchanged for the transmission of the Instant messages.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
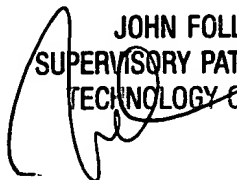
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Abp
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JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100